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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,815	04/09/2004	Miles Paschini	EWIR-001/03US 300933-2009	9103
23419 7590 08/05/2009 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,815

Applicant(s)

PASCHINI ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicants papers filed on May 4, 2009 is hereby acknowledged. Claims 1-15 are pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2009 has been entered.

Response to Arguments

2. The Applicant states that the prior art reference fail to disclose the claimed feature of "generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value,"

The Examiner states that Brody discloses "There is disclosed a currency transfer system and method which utilizes the existing ATM network but which provides for the temporary assignment of a PIN number and the temporary establishment of a credit limit within an existing account. Using the system a customer can, by using a temporary PIN at an ATM machine, withdraw an amount equal to or less than the temporary credit limit.

The depositing customer purchases temporary ATM cards which have contained within them preprogrammed credit limits which are then read into the system under an assigned temporary PIN number." Abstract. The Examiner submits that the disclosed feature of "provides for the temporary assignment of a PIN number and the temporary

establishment of a credit limit within an existing account” meets the claimed limitation of “generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value,”

In regard to claims 9-15, the Examiner would like to point out that the language that Applicant considers lacking from the prior art is directed towards intended use (e.g. “configured for”) and it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

The Examiner further states that the claim language “a client request indicative of a particular monetary value” does not mean that the request is actually made, this is not a positive claim limitation.

The applicants arguments in regard to the dependant claims have been fully considered, however the same arguments as presented above likewise apply to the dependant claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 1 fails prong (1) because the “tie” (e.g. server, host connection manager) are representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps in claim 1 are: generating a PIN at the server. The claim states “transmitting the request for the PIN from the host connection manager to a the server; receiving the PIN at the host connection manager; receiving, at the host connection manager however there is no process for generating the PIN.

Claims 2-21 are either dependant upon claim 1 or contain similar limitations and are rejected for at least the same reasons.

Claim 1 further recites the feature of “a client request generated and transmitted from the client terminal, said client request indicative of the particular monetary value”, is unclear whether this is a new request or the request referrer to in the transmitting step. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...In re Zletz 13 USPQ2d 1320 (Fed. Cir. 1989).

Claims 2-8 are either dependant upon claim 1 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being obvious in view of Brody et al. (US Patent 5,350,906) in view of Konya (US Patent 5,350,906).

5. As per claims 1 and 9,

Brody et al. discloses a method of distributing a personal identification number (PIN) through a client terminal, comprising:
generating, at a host connection manager, a request for a PIN, wherein the PIN is associated with a particular monetary value;(Abstract)

transmitting the request for the PIN from the host connection manager to a server;
receiving the PIN at the host connection manager; (Column 7, lines 14-24 receiving, at a host connection manager, a client request generated and transmitted from a client terminal, said client request indicative of the particular monetary value,(Figure 3 – step 305 “read amount ”; Figure 3 -- step 311 send PIN; also at Column 7, lines 14-24)
Brody et al. does not explicitly disclose “sending the PIN to the client terminal in response to the client request ” Konya discloses “sending the PIN to the client terminal in response to the client request ” (Column 11, lines 11-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the

Brody et al. method with the Konya method in order to manage PIN codes from a centralized location; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

6. As per claims 2 and 10,

Brody et al. discloses the method of claim 1 wherein the generating a request for a PIN is initiated in response to the receiving of the client request at the host connection manager.(Figure 3 – when the card is read it generates a response request)

7. As per claims 3 and 11,

Brody et al. discloses the method of claim 1 wherein the generating is in advance of the receiving of the client request at the host connection manager. (Figure 1)

8. As per claims 4 and 12

Brody et al. discloses the method of claim 3, further including:

storing, at the host connection manager, the PIN in a PIN cache; and retrieving the PIN from the PIN cache in response to the receiving of the client request at the host connection manager. (Column 7, lines 14-24)

9. As per claim 5

Brody et al. discloses the method of claim 1,
wherein the transmitting the request for the PIN includes transmitting the request for the PIN via a first network, and wherein the client request is transmitted from the client terminal to the host connection manager via a second network. (Figure 1)

10. As per claims 6 and 13

Brody et al. discloses the method of claim 5,
wherein the transmitting the request for the PIN via the first network from the host connection manager to the server is in accordance with a first communication protocol and wherein the client request is transmitted to the host connection manager from the client terminal via the second network in accordance with a second communication protocol.(Column 5, lines 22-36)

11. As per claim 7

Brody et al. discloses the method of claim 6,
wherein the first network and the second network comprise a single common network.(Figure 1)

12. As per claims 8 and 14,15

Brody et al. discloses the method of claim 1,
wherein no inventory of PINs is stored at the client terminal.(Abstract --

temporary Pin is used)

In regard to claims 9-15, Examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

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